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2006 WL 2523548 (Bd.Pat.App & Interf.)
(Cite as: 2006 WL 2523548 (Bd.Pat.App & Interf.))

*1 THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

Board of Patent Appeals and Interferences

Patent and Trademark Office (P.T.O.)
EX PARTE YOSHIO OKAMOTO, KOICHI HATADA, TOHRU SHIBATA, ICHIRO OKAMOTO, AND
HIROYUKI NAKAMURA
Appeal No. 2000-0132
Application No. 08/934,791
October 21, 2002

FLYNN, THIEL, BOUTELL & TANIS, P.C.

20226 RAMBLING RD.

KALAMAZOO, MI 49008-1699

Before PAK, DELMENDO, and PAWLIKOWSKI

Administrative Patent Judges

PAK

Administrative Patent Judge

ON BRIEF

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 21 through 25, 27, 31, 44 through 46, 48, 52, 54, 55 and 61, which are all of the claims pending in the above-identified reissue application.

APPEALED SUBJECT MATTER

Claims 21, 22, and 54 are representative of the subject matter on appeal and read as follows: [FN1]

21. In a chromatographic column used in the separation of a chemical substance from a mixture containing the same, the improvement comprising said column containing a carrier having supported thereon a separating agent comprising a cellulose derivative consisting of cellulose having an aromatic substituent attached thereto through a urethane group.

22. In a chromatographic column used in the separation of a chemical substance from a mixture containing the same, the improvement comprising said column containing a separating agent in the form of beads and comprising a cellulose derivative consisting of cellulose having an aromatic substituent attached thereto through a urethane group.

54. In a chromatographic column used in the separation of a chemical substance from a mixture containing the same, the improvement comprising said column containing a separating agent comprising a ground cellulose derivative having an aromatic substituent attached thereto through a urethane group, said aromatic substituent being ring substituted with a group selected from among an alkyl group, an alkenyl group, an alkynyl group, a nitro group, a halogen group, an amino group,

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an alkyl-substituted amino group, a cyano group, a hydroxyl group, an alkoxy group, an acyl group, a thiol group, a sulfonyl group, a carboxyl group and an alkoxy carbonyl group.

PRIOR ART

As evidence of obviousness, the examiner relies on the following prior art references:

Determann et al. (Determann)	3,841,126	Oct. 15, 1974
Porath et al. (Porath)	3,960,720	Jun. 1, 1976
Schaeffer et al. (Schaeffer)	4,111,838	Sep. 5, 1978
Ayers et al. (Ayers)	4,330,440	May 18, 1982
Yuki et al. (Yuki)	4,375,495	Mar. 1, 1983

*2 Hagel, Chromatographische Racemattrennung An Celluloseetriacetat, pp. 134- 35, (1976). [FN2]

Mikes' Laboratory Handbook of Chromatographic and Allied Methods, pp. 479-80 and 540-41 (John Wiley and Sons, NY, 1979) (hereinafter referred to as "Mikes").

THE REJECTIONS

The appealed claims stand rejected as follows:

- 1) Claims 21 through 25, 27, 31, 44 through 46, 48, 52, 54, 55 and 61 under 35 U.S.C. § 251 as "lacking reissuable error";
- 2) Claims 21 through 25, 27, 31, 44 through 46, 48, 52, 54, 55 and 61 under 35 U.S.C. § 251 as "not being drawn to the same invention as the original patent";
- 3) Claims 21 through 25, 27, 31, 44 through 46, 48, 52, 54, 55 and 61 under 35 U.S.C. § 251 as being based on a defective reissue declaration;
- 4) Claims 21 through 23, 25, 44 and 46 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Hagel and Mikes [FN3];
- 5) Claims 21 and 23 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Hagel, Mikes and Schaeffer;
- 6) Claims 24, 44 and 45 under 35 U.S.C. § 103 as unpatentable over Hagel, Mikes and Determann;
- 7) Claims 27, 31, 48 and 52 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Hagel, Mikes, Porath and Ayers;
- 8) Claims 54 and 61 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Hagel, Mikes, Ayers and Yuki; and
- 9) Claim 55 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Hagel, Mikes, Ayers, Yuki and Determann.

OPINION

We have carefully reviewed the claims, specification and applied prior art, including all of the arguments and evidence advanced by both the examiner and appellants in support of their respective positions. As a result of this review, we make the following determinations.

35 U.S.C. § 251

We turn first to the examiner's rejection of claims 21 through 25, 27, 31, 44 through 46, 48, 52, 54, 55 and 61 under 35 U.S.C. § 251 as lacking a "reissuable error." 35 U.S.C. § 251 provides:

Whenever any patent is, through error without any deceptive intention, deemed

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wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

*3 The Commissioner may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

According to the examiner (Answer, page 5):

The claims presented in the instant reissue application are drawn to the [sic, a] combination of one of the nonelected species (from the original election requirement) together with a carrier in a chromatographic column. The examiner goes on to state that this original election requirement is tantamount to a restriction requirement for the instantly claimed combination and by not filing a divisional application, appellants had intentionally surrendered such claimed subject matter. See the Answer, pages 13-15. The examiner then concludes that the appellants fail to state "error" capable of being remedied under Section 251 consistent with In re Orita, 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977). Id.

When applicants cancel claims to the non-elected invention in response to the examiner's restriction requirement, and then fail to file a divisional application embodying the canceled claims, the applicants are deemed to have acquiesced to the restriction and are estopped from obtaining by reissue the subject matter of the canceled claims. In re Weiler, 790 F.2d 1576, 1582-83, 229 USPQ 673, 677 (Fed. Cir. 1986); Orita, 550 F.2d at 1280, 193 USPQ at 148. According to Orita, there is no correctable error in failing to prosecute the divisional application on the non-elected inventions identified by the examiner in the restriction requirement. Id.

In the present case, no formal restriction requirement of claims drawn to a combination of a separating agent and a chromatographic column was ever imposed by the examiner, or acquiesced by the appellants, since they were not presented in the appellants' original application. Thus, it cannot be argued that the appellants' failure to file a divisional application to such subject matter was a deliberate act and not an error under Section 251. Compare In re Doyle, 293 F.3d 1355, 63 USPQ2d 1161 (Fed. Cir. 2002).

*4 It is important to recognize that Section 251 is a remedial statute which must be interpreted liberally. Weiler, 790 F.2d at 1579, 229 USPQ at 675. "Although attorney error is not an open invitation to reissue in every case ... the purpose of the reissue statute is to avoid forfeiture of substantive rights due to error made without intent to deceive." Scripps Clinic & Research Found. v. Genentech, Inc., 927 F.2d 1565, 1575, 18 USPQ2d 1001, 1009 (Fed. Cir. 1991). Accordingly, we decline to extend any per se or mechanical rule against reissue where the claims cover "statutorily different" subject matter which have not been formally restricted or cancelled in the appellants' original application.

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The examiner also takes the position that 35 U.S.C. § 251 does not authorize reissuance of U.S. Patent No. 4,818,394 through the present reissue application since upon issuance of the first reissue application as U.S. Patent No. Re 34,457, the surrender of U.S. Patent 4,818,394, by operation of law, took effect. We cannot subscribe to the examiner's position.

In reference to our decision in Ex part Graff, No. 95-1307 (Bd. Pat. App. & Int. Mar. 7, 1996) involving the same issue, our reviewing court in In re Graff, 111 F.3d 874, 876, 42 USPQ2d 1471, 1473 (Fed. Cir. 1997) stated that:

The Board held that 35 U.S.C. § 251 does not authorize reissuance of the surrendered '928 patent through Mr. Graff's second reissue application. However, § 251 does not bar multiple reissue patents in appropriate circumstances. Section 251 [3] provides that the general rules for patent applications apply to reissue applications, and § 251 [2] expressly recognizes that there may be more than one reissue patent for distinct and separate parts of the thing patented. The statute does not prohibit divisional or continuation reissue applications, and does not place stricter limitations on such applications when they are presented by reissue, provided of course that the statutory requirements specific to reissue applications are met.

Implicit in Graff is that the surrender of a defective patent does not occur until all of the continuation or divisional reissue applications are issued consistent with Section 251, paragraphs 2 and 3. Thus, it cannot be argued that Section 251 does not authorize reissuance of U.S. Patent No. 4,818,394 through the present reissue application.

*5 In view of the foregoing, we reverse the examiner's Section 251 rejection based on lacking statutory basis for failure to state "error" capable of being remedied under Section 251.

We turn next to the examiner's rejection of claims 21 through 25, 27, 31, 44 through 46, 48, 52, 54, 55 and 61 under 35 U.S.C. § 251 as "not being drawn to the same invention as the original patent." According to the examiner (Answer, page 13):

If it were found to that the election of species requirement did not apply to the column claims, then the only explanation could be that the rejection under 35 U.S.C. § 251 as not being drawn to the same invention as the original patent is proper [sic].

However, the appellants correctly point out that Section 251 "does not prohibit the reissue of claims directed to a different statutory class of invention than the claims that issued in the original patent." See the Brief, page 8. The first paragraph of Section 251 provides that:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, ... by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall ... reissue the patent for the invention disclosed in the original patent
[Emphasis ours.]

Consistent with this statutory language, our reviewing court in In re Amos, 953 F.2d 613, 618, 21 USPQ2d 1271, 1275 (Fed. Cir. 1991) stated that

the inquiry under § 251 as to whether the new claims are for the invention originally disclosed is analogous to the analysis required by § 112, ¶ 1. Since the examiner has not argued, much less demonstrated, that the presently claimed subject matter is not originally described within the meaning of § 112, paragraph 1, we reverse this Section 251 rejection as well.

We turn next to the examiner's rejection of claims 21 through 25, 27, 31, 44 through 46, 48, 52, 54, 55 and 61 under 35 U.S.C. § 251 as being based on a defective reissue declaration. According to the examiner (Answer, page 7):

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The reissue oath or declaration filed with this application and the supplemental reissue declaration of March 2, 1998 are defective because they fail to particularly specify an error relied upon, as required under 37 CFR § 1.175. 35 U.S.C. § 251 provides in relevant part:

*6 Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, ... by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall ... reissue the patent for the invention disclosed in the original patent

....
This reissue statute does not require that the appellants particularly specify the errors relied upon. Nor does 37 CFR § 1.175 (1998), [FN4] which is derived from the reissue statute, require the appellants to particularly specify the errors relied upon. Specifically, it only requires that: [FN5]

(1) The applicant believes the original patent to be wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent, stating at least one error being relied upon as the basis for reissue; and

(2) All errors being corrected in the reissue application ... arose without any deceptive intention on the part of the applicant.

This new rule, as correctly stated by the appellants at page 8 of the Brief, "only requires the identification of at least one error and a general statement that the errors arose without deceptive intent" Thus, we determine that the instant reissue oaths or declarations meet the requirements of the new rule for the reasons set forth by the appellants in their Brief. Accordingly, we reverse this Section 251 rejection as well.

PRIOR ART REJECTIONS UNDER SECTION 103

We turn next to the examiner's rejection of claims 21 through 23, 25, 44 and 46 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Hagel and Mikes. We find that Hagel teaches using cellulose triphenyl carbamate as a sorbent to determine its efficiency in a chromatographic system. See pages 1 and 2. We find that the claimed separating agent embraces cellulose triphenyl carbamate. See appellants' claim 25. We find that Hagel teaches that the cellulose triphenyl carbamate is superior in terms of separating certain components than amorphous cellulose triacetate. See page 2. We find that this superior sorbent is in the form of particles, i.e., sieve fractions 90-56 micrometers. [FN6] See page 1. We find that these particles (sieve fractions) necessarily include beads since they are produced in a similar manner as that (filtering) described in the Rule 132 declaration executed by Mr. Ichida and Mr. Ikeda on September 1, 1995. In any event, we find that these particles are not limited to any particular shapes and are known to include those in the form of beads. Moreover, it is well known to use sorbents, including cellulose sorbents, in the form of beads in chromatography separation. See, e.g., Determann, column 2, lines 1-5 and Schaeffer, column 2, lines 15-20.

*7 Given these teachings, we concur with the examiner that one of ordinary skill in the art would have been led to employ cellulose triphenyl carbamate particles, including those in the form of beads, in a chromatographic column, with a reasonable expectation of successfully using them in chromatography separation. Hence, we conclude that the examiner has established a prima facie case of obviousness regarding the subject matter of claims 22 and 25. In reaching this conclusion, we also note that the appellants "do not dispute that Mikes combined with Hagel would suggest to one of ordinary skill in the art that cellulose trisphenylcarbamate could be used as a separating agent in a chromatographic column." See the Brief, page 10.

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However, we determine that claims 21, 23, 44 and 46 are on different footing. Although these claims require that cellulose triphenyl carbamate be supported on a carrier, the examiner does not indicate that Hagel and Mikes individually, or in combination, teach or suggest such a feature. Hence, we conclude that the examiner has not established a prima facie case of obviousness regarding the subject matter of claims 21, 23, 44 and 46.

Recognizing the deficiency of Hagel and Mikes, the examiner further relies on Schaeffer to reject claims 21 and 23 under 35 U.S.C. § 103. [FN7] We find that Schaeffer teaches that polysaccharide separating agents can be covalently bonded to any inorganic support, including glass beads, to provide a high degree of purification with high flow rates in chromatographic separation. See column 2, lines 8-25, together with column 1, lines 15-40. The polysaccharide separating agents generically described in Schaeffer include the polysaccharide separating agent, i.e., cellulose triphenyl carbamate, described in Hagel. See, e.g., Schaeffer, column 1, lines 15-17.

Thus, the appellants' arguments to the contrary notwithstanding, we determine that one of ordinary skill in the art would have been led to employ an inorganic carrier, such as glass beads, as a support for the cellulose derivative separating agent described in Hagel, with a reasonable expectation of successfully improving purification levels and flow rates in chromatographic separation. Hence, we conclude that the examiner has established a prima facie case of obviousness regarding the subject matter of claims 21 and 23.

The examiner mistakenly believes that Hagel does not teach the particle size recited in claims 24, 44, and 45. Thus, the examiner further relies on Determann, in addition to the combined disclosures of Hagel and Mikes, for such a teaching. The disclosures of Hagel and Mikes are discussed above. As indicated supra, Hagel teaches the claimed particle size. Moreover, we find that Determann teaches that regenerated cellulose particles having sizes in the range of 0.01 to 1 millimeter can be used as a sorbent in chromatography separation. See column 1, lines 35- 71. From this teaching, one of ordinary skill in the art can infer that the sorbent particles employed in chromatography separation can be in the range of 0.01 to 1 millimeter. This is especially true since one of ordinary skill in the art is aware that polysaccharides inclusive of cellulose and regenerated cellulose sorbents are known to be used interchangeably in chromatographic separation. See, e.g., Ayers, abstract. Hence, we conclude that the examiner has established a prima facie case of obviousness regarding the subject matter of claims 24, 44 and 45.

*8 The examiner also mistakenly believes that Hagel does not teach or would have suggested the aromatic substituents recited in claims 27, 31, 48 and 52. Thus, the examiner relies on the disclosures of Porath and Ayers, in addition to the disclosures of Hagel and Mikes, for such a teaching. Although we concur with the appellants that Porath and Ayers would not have suggested the claimed, substituted cellulose triphenyl carbamate, we find that Hagel alone would have at least suggested the claimed substituted cellulose triphenyl carbamate, e.g, one substituted with methyl. [FN8] One of ordinary skill in the art, due to structural similarities between the compounds involved, would have had a reasonable expectation of successfully obtaining sorbents having the same or similar property. Hence, we conclude that the examiner has established a prima facie case of obviousness regarding the subject matter of claims 27, 31, 48, and 52.

The examiner further mistakenly believes that Hagel does not teach the ground cellulose triphenyl carbamate particles recited in claims 54, 55, and 61. Thus, the examiner relies on the disclosures of Ayers, Yuki, and Determann, in addition to

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the disclosures of Hagel and Mike, for ground cellulose triphenyl carbamate particles having the claimed size. We need not consider the disclosures of Ayers, Yuki, and Determann since Hagel teaches or at least would have suggested ground cellulose triphenyl carbamate particles having the claimed size as indicated supra. Hence, we conclude that the examiner has established a prima facie case of obviousness regarding the subject matter of claims 54, 55, and 61.

The appellants rely on the Rule 132 declaration executed by Akito Ichida and Hirokazu Ikeda to show that the claimed subject matter imparts unexpected results, thereby rebutting the prima facie case established by the examiner. Having carefully reviewed the showing in the declaration, we are not persuaded that the appellants have carried their burden of showing unexpected results. See In re Klosak, 455 F.2d 1077, 1080, 173 USPQ 14, 16 (CCPA 1972).

We initially observe that the appellants rely on a comparative showing between separating agent 1c supposedly corresponding to the ground cellulose triphenyl carbamate described in Hagel and separating agent 3c corresponding to the cellulose triphenyl carbamate beads recited in, e.g., claims 22 and 25. However, as indicated supra, we find that Hagel teaches cellulose triphenyl carbamate particles (sieve fractions) which of necessity includes those which are in the form of beads. Thus, we determine that a showing of unexpected results is not relevant in this situation because bead shapes are not the novel aspect of the claimed invention. In re Malagari, 499 F.2d 1297, 1302, 182 USPQ 549, 553 (CCPA 1974).

Even if we were to determine that Hagel does not necessarily teach the claimed bead shapes, our conclusion would not be altered. We find that the declarants do not specify the size or type of bead shape particles used in the comparative showing provided in the declaration. Thus, it cannot be ascertained from the comparative showing whether the alleged improvements are due to the size of particles employed, the type of bead shapes employed or any bead shapes as alleged and claimed. In re Dunn, 349 F.2d 433, 439, 146 USPQ 479, 483 (CCPA 1965) ("While we do not intend to slight the alleged improvements, we do not feel it an unreasonable burden on appellants to require comparative examples relied on for non-obviousness to be truly comparative. The cause and effect sought to be proven is lost here in the welter of unfixed variables"). Moreover, as found by the examiner (Answer, page 21), the declarants fail to compare the claimed invention with the closest prior art, i.e., the ground cellulose triphenyl carbamate having a particle size of 56-90 microns (not 7 to 13 microns) described in Hagel. See In re Baxter Travenol Labs., 952 F.2d 388, 392, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991).

*9 We also observe that the appellants rely on a comparative showing between separating agent 1c supposedly corresponding to the ground cellulose triphenyl carbamate described in Hagel and separating agent 3c corresponding to the supported cellulose triphenyl carbamate recited in, e.g., claim 21 and 46. However, for the reasons set forth by the examiner at page 20 of the Answer, we determine that the alleged improvement would have been reasonably expected by one of ordinary skill in the art from the teachings of Schaeffer. See, e.g., In re Skoner, 517 F.2d 947, 950, 186 USPQ 80, 82 (CCPA 1975) ("[e]xpected beneficial results are evidence of obviousness of a claimed invention just as unexpected beneficial results are evidence of unobviousness").

Even if we were to determine that the alleged improvements are unexpected, our conclusion would not be altered. We determine that the showing is not reasonably commensurate in scope with the protection sought by the appealed claims. See In re Clemens, 622 F.2d 1029, 1035, 206 USPQ 289, 296 (CCPA 1980). While the showing is limited to cellulose triphenyl carbamate particularly bonded to a particular carrier, the appealed claims are not so limited. On this record, the appellants

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have not demonstrated that the improvements obtained by using the particular bonding technique and the particular carrier can be extended to those sorbents produced by using the materially different carriers and materially different bonding techniques covered by the appealed claims.

We further observe that the appellants rely on a comparative showing between separating agent 1c supposedly corresponding to the ground cellulose triphenyl carbamate described in Hagel and separating agents 1d and 2d corresponding to the substituted cellulose triphenyl carbamate with or without a carrier recited in, e.g., claims 27, 31, 48, 52, 54, 55 and 61. However, as found by the examiner (Answer, page 21), we determine that the showing is not reasonably commensurate in scope with the protection sought by the appealed claims. Clemens, 622 F.2d at 1035, 206 USPQ at 296. While the showing is limited to cellulose tri(3,5-dimethylphenyl carbamate) alone or cellulose tri(3,5-dimethylphenyl carbamate) particularly bonded to a particular carrier, the appealed claims are not so limited. Nevertheless, the appellants have not demonstrated that a claimed substituted cellulose derivative structurally more similar to the cellulose triphenyl carbamate described in Hagel, such as, e.g., cellulose tri(methylphenyl carbamate) covered by the appealed claims, can produce the same improvements as cellulose tri(3,5-dimethylphenyl carbamate). [FN9] Moreover, the appellants have not demonstrated that the improvements obtained by using the particular bonding technique and the particular carrier can be extended to those sorbents produced by using the materially different carriers and materially different bonding techniques covered by the appealed claims.

NEW GROUND OF REJECTION

*10 Pursuant to the provisions of 37 CFR § 1.196(b) (1999), we make a new ground of rejection against claim 46 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Hagel, Mikes and Schaeffer for the reasons set forth above.

CONCLUSION

In view of the foregoing:

- 1) The examiner's rejection of claims 21 through 25, 27, 31, 44 through 46, 48, 52, 54, 55 and 61 under 35 U.S.C. § 251 as "lacking reissuable error" is reversed;
- 2) The examiner's rejection of claims 21 through 25, 27, 31, 44 through 46, 48, 52, 54, 55 and 61 under 35 U.S.C. § 251 as "not being drawn to the same invention as the original patent" is reversed;
- 3) The examiner's rejection of claims 21 through 25, 27, 31, 44 through 46, 48, 52, 54, 55 and 61 under 35 U.S.C. § 251 as being based on a defective reissue declaration is reversed;
- 4) The examiner's rejection of claims 21, 23, 25, 29, 44 and 46 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Hagel and Mikes is reversed;
- 5) The examiner's rejection of claims 22 and 25 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Hagel and Mikes is affirmed;
- 6) The examiner's rejection of claims 21 and 23 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Hagel, Mikes, and Schaeffer is affirmed;
- 7) The examiner's rejection of claims 24, 44, and 45 under 35 U.S.C. § 103 as unpatentable over Hagel, Mikes and Determann is affirmed;
- 8) The examiner's rejection of claims 27, 31, 48 and 52 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Hagel, Mikes, Porath, and Ayers is affirmed;
- 9) The examiner's rejection of claims 54 and 61 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Hagel, Mikes, Ayers, and Yuki is

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affirmed;

10) The examiner's rejection of claim 55 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Hagel, Mikcs, Ayers, Yuki, and Determann is affirmed; and

11) Pursuant to the provisions of 37 CFR § 1.196(b), we made a new ground of rejection against claim 46 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Hagel, Mikes, and Schaeffer.

Pursuant to the provisions of 37 CFR § 1.196(b), we also denominate our affirmance of the aforementioned Section 103 rejections as including new rejections inasmuch as our rationale for affirming the aforementioned Section 103 rejections is materially different from those set forth by the examiner.

*11 This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART; 37 CFR § 1.196(b)

BOARD OF PATENT APPEALS AND INTERFERENCES

CHUNG K. PAK

Administrative Patent Judge

ROMULO H. DELMENDO

Administrative Patent Judge

BEVERLY A. PAWLIKOWSKI

Administrative Patent Judge

FN1. The amendment which was submitted together with a response dated Dec. 2, 1996 (Paper No. 17), was not clerically entered. Upon return of this application, the examiner must ensure proper entry of this amendment.

FN2. Our reference to this literature is to the corresponding English translation of record.

FN3. The examiner has inadvertently included cancelled claim 29 in this rejection. Accordingly, we have omitted claim 29 from this rejection.

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FN4. This rule became effective on December 1, 1997, during the pendency of this patent application. When a rule is changed during the pendency of a patent application, the rule in effect on the date of our decision is the one that controls. Compare Shockley v. Arcan, Inc., 248 F.3d 1349, 1358-59, 58 USPQ2d 1692, 1697 (Fed. Cir. 2001).

FN5. 37 CFR § 1.175 (a)(1) and (a)(2) (1998)

FN6. In the event of further prosecution, the examiner should include claim 24 in this rejection as Hagel fully describes the particle size recited in claim 24.

FN7. We note that the examiner carelessly left out claims 44 and 46 in this rejection. In the event of further prosecution, the examiner should include claims 44 and 46 in this rejection.

FN8. The claimed alkyl group includes methyl.

FN9. A showing of unexpected results must be commensurate in scope with the appealed claims only to the extent that the examiner has established a prima facie case of obviousness. Compare In re Wakefield, 422 F.2d 897, 901, 164 USPQ 636, 639 (CCPA 1970).

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